

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Herwig MIESSBACHER Group Art Unit: 3651
Appln. No. : 10/559,537 Confirmation No.: 9141
I. A. Filed : June 4, 2004 Examiner: James R. Bidwell
For : HANDRAIL, HANDRAIL GUIDING SYSTEM, AND
HANDRAIL DRIVE SYSTEM OF AN ESCALATOR OR
MOVING SIDEWALK

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Amendment
Randolph Building
401 Dulany Street
Alexandria VA 22314

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

In response to the Examiner's restriction requirement of September 10, 2008, the time set for response being one month from the mailing date from the U.S. Patent and Trademark Office, i.e., October 10, 2008, Applicants hereby elect the invention of Group I, including claims 52 – 73, 81 – 125 and 127. The above election is made with traverse for the reasons set herein below.

In the Restriction Requirement of September 10, 2008, the Examiner indicated that all claims (52 – 127) were subject to restriction under 35 U.S.C. § 121. The Examiner restricted the claimed invention into Group I, including claims 52 – 73, 81 – 125 and 127, drawn to a handrail drive system, classified in class 198, subclass 330, Group II, including claims 74 – 80, drawn to a handrail guide sliding surface, classified in

class 198, subclass 335 and Group III, including claim 126, drawn to a combination of groups I and II, classified in class 198, subclasses 330 and 335.

The Examiner asserted that inventions I and II were related subcombinations disclosed as usable together in a single combination, and that the inventions are distinct from each other under M.P.E.P. § 806.05(d) because "invention I has a separate utility such as driving a belt which is used to convey products." Additionally, the Examiner asserted that the invention of Group III is a linking claim, wherein the restriction requirement between the linked inventions (i.e., Groups I and II) is subject to the nonallowance of the linking claim, claim 126.

Applicants respectfully submit that the Examiner has omitted one of the two criteria for a proper restriction requirement now established by the U.S. Patent and Trademark Office policy. That is, as set forth in M.P.E.P. § 803, "an appropriate explanation" must be advanced by the Examiner as to the existence of a "serious burden" if the restriction requirement were not required.

In this regard, Applicants submit that the Examiner has not set forth the requisite assertion of a serious burden nor an appropriate explanation. That is, the Examiner has not made any statement as an existence of a serious burden were the restriction requirement not required.

Moreover, Applicants submit that the invention of Group I includes features directed to the handrail guiding system (see, e.g., claims 87 – 95, 98 and 99). As such, Applicants submit searching group I requires searching the features of the handrail guiding system. Thus, Applicants respectfully submit that a concurrent examination of the groups would not present a "serious burden."

Additionally, Applicants note that the Examiner-identified Group I, which Applicants have hereby elected for examination, includes claims 116 – 118 which are dependent from claim 74 of Group II. Thus Applicants submit a search of claims 116 – 118 would necessarily require a search of at least claim 74. As such, Applicants submit that a concurrent examination of the groups would not present a “serious burden.”

Still further, Applicants note that, as the Examiner has acknowledged that the three identified groups of invention would be classified in the same Class 198, it is not apparent that a concurrent examination of the groups would present a “serious burden.” Further, the Examiner has failed to provide an appropriate statement that the search areas required to examine the invention of group I would not overlap into the search areas for examining the invention of group II, and vice versa, and would not overlap into the search areas for examining the invention of group III, and vice versa, and the invention of group II would not overlap into the search areas for examining the invention of group III, and vice versa. Thus, Applicants respectfully submit that the search for the combination of features recited in the claims of the above-noted groups, if not totally co-extensive, would appear to have a very substantial degree of overlap.

Because the search for each group of invention is substantially the same, Applicants submit that no undue or serious burden would be presented in concurrently examining Groups I, II and III. Thus, for the above-noted reasons, and consistent with the office policy set forth above in M.P.E.P. § 803, Applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement in this application.

For all of the above reasons, the Examiner's restriction is believed to be improper. Nevertheless, Applicants have elected, with traverse, the invention defined by Group I,

i.e., claims 52 – 73, 81 – 125 and 127 in the event that the Examiner chooses not to reconsider and withdraw the restriction requirement.

Should the Examiner have any questions or comments, he is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,
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